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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,964	08/18/2006	Volkmar Klein	51783	1056

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EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

07/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,964

Applicant(s)

KLEIN ET AL.

Examiner

MADELINE GONZALEZ

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In response to applicant's amendment dated March 20, 2008

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 13-21 and 23 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Nichtnennung (DE 3100499A1).

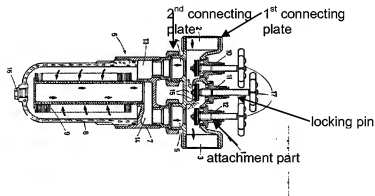
With respect to **claim 11**, Nichtnennung discloses a filter device, as shown in Fig. 1, having:

- a filter housing 6 having first and second fluid connections and an exterior surface;
- a filter element 9 held in said filter housing 6;
- a fluid container having an exterior surface, said fluid container being the element connected to the filter device (not shown), and
- a connector 1 coupling said fluid connections to said fluid container, said connector 1 having at least one longitudinally displaceable blocking part 10, 11, 12, blocking said fluid connections in a blocking position thereof and opening said fluid connections in an open position thereof, said blocking part 10, 11, 12,

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being located between and accessible from said exterior surfaces of said filter housing 6 and said fluid container when said filter housing 6 and said fluid container are coupled by said connector 1.

With respect to **claim 13**, Nichtnennung discloses wherein said blocking part 10, 11, 12, includes a plate-shaped sliding valve part guided for movement between and sealed between first and second connecting plates of said connector 1 by seals facing said filter housing and facing said fluid container, as shown in the figure below.



With respect to **claim 14**, Nichtnennung discloses wherein said fluid connections include a fluid inlet and a fluid outlet in said filter housing 6; said connecting plates include fluid passages corresponding to and forming part of said fluid connections; and said blocking part 10-12 has wall parts that cover said fluid connections in the blocking position and clear said fluid connections in the open position, as shown in Fig. 1.

With respect to **claim 15**, Nichtnennung discloses wherein said fluid inlet and said fluid outlet are located one of top of another in a direction of a longitudinal axis of said filter housing 6, as shown in the figure above; said fluid passages are located one on top of another in said direction of said longitudinal axis; and said blocking part 10-12 has clearance openings 15 between said wall parts, said clearance openings 15 being aligned and congruent with said fluid passages in the open position to convey fluid therethrough, as shown in Fig. 1.

With respect to **claim 16**, Nichtnennung discloses wherein said first and second fluid connection has first and second valves 10-12, respectively, as shown in Fig. 1.

With respect to **claim 17**, Nichtnennung discloses wherein said first fluid connection includes a fluid outlet 14 of said filter housing 6, with said first valve 12 having a valve disk located on an outside of and over said fluid outlet 14; and said fluid connection includes a fluid inlet 13 of said filter housing 6, with said second valve 10 having a valve disk integrated within said filter inlet 13, as shown in Fig. 1.

With respect to **claim 18**, Nichtnennung discloses wherein said filter connections of said filter housing 6 are encompassed on an outer peripheral side thereof by an attachment part; and said connector 1 has flange parts on a connecting plate thereof facing said attachment part, said connecting plate having fluid passages therein encompassed by said flange parts, as shown in the figure above.

With respect to **claim 19**, Nichtnennung discloses wherein said attachment part includes a locking part received in an opening in one of said flange parts and in a recess in said blocking part 10-12 in the open position, as shown in Fig. 1.

With respect to **claim 20**, Nichtnennung discloses wherein said locking device includes a locking pin, as shown in the figure above.

With respect to **claim 21**, Nichtnennung discloses wherein each of said filter housing 6 and said blocking part 10-12 include a handle for manual operation thereof, as shown in Fig. 1.

With respect to **claim 23**, Nichtnennung discloses wherein said blocking plate 10-12 moves translaterally between the blocking and open positions, as shown in the figure above.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is finally rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nichtnennung (DE 3100499A1).

Claim 12 adds the further limitation of a hydraulic tank.

Nichtnennung **lacks** a hydraulic tank. However, it appears that the hydraulic tank is not part of the claimed invention, as shown in applicant's drawings in Figs. 1-3, and therefore, the examiner has not give patentable weight to the hydraulic tank. Furthermore, in the alternative, it would be obvious to use the filter device disclosed by Nichtnennung with a hydraulic tank in order to filter hydraulic fluid. There is no structural difference between the claimed invention and the filter device disclosed by Nichtnennung, which is capable of being used with a hydraulic tank.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22 and 24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtnennung (DE 3100499A1).

Claim 22 adds the further limitation of wherein said filter housing comprises cast aluminum; and said blocking part comprises one of steel and plastic.

Nichtnennung **lacks** the specific claimed materials.

The MPEP 2144.07 states as obvious "The selection of a known material based on its suitability for its intended use". It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a cast aluminum material and steel or plastic, as claimed by applicant, to make the housing and the blocking part disclosed by Nichtnennung, since that would be considered the preferred material used based on its suitability for its intended use.

Claim 24 adds the further limitation of wherein said fluid connections extend perpendicular to a longitudinal axis of said filter housing.

Nichtnennung **lacks** the specific location of the fluid connections.

It would have been obvious to provide the filter device disclosed by Nichtnennung with the fluid connections extending perpendicular to the longitudinal axis of the housing, as claimed by applicant, since the courts have held that shifting the position of a particular element is unpatentable as long as the operation of the device is not modified (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)).

Response to Arguments

Applicant's arguments with respect to claims 11-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MADELINE GONZALEZ** whose telephone number is (571)272-5502. The examiner can normally be reached on **M-F 8:30am-5:00pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez
Patent Examiner
July 22, 2008

/Krishnan S Menon/
Primary Examiner, Art Unit 1797